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Application No.: 10/085,526  
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### REMARKS

This Response is submitted in reply to the Office Action mailed June 2, 2004 ("the Action"). Claims 1-19 are pending in the application but stand rejected under 35 USC §112 as being indefinite for the use of certain claim informalities. The Action also rejects Claims 1-5 and 7-19 under 35 USC §102 (a or e) as being anticipated by U.S. Patent Application Publication No. 20040019385 to Ayers et al. ("Ayers"). Claims 1-5 and 16-19 stand rejected under 35 USC §102(b) as being anticipated by Japanese document 1-108143 and U.S. Patent No. 4,195,366 to Jarcho et al. ("Jarcho"). Applicants respectfully disagree.

#### A. Allowable Subject Matter

Applicants acknowledge with appreciation, the Examiner's statement that Claim 6 would be allowable if rewritten to overcome the claim informality issues. The Action states at page 5, with respect to allowable subject matter in Claim 6, that the prior art of record fails to teach or suggest a porosity of 2-15 microns. Applicants believe that a more precise statement may be that the prior art fails to teach, *inter alia*, a product having a generally uniform sintered structure with interconnected microporosity having pore widths and/or a matrix of primary particles that is tightly sintered to provide the microporosity as claimed. Further, Applicants respectfully submit that the pending claims recite an additional novel features which, *inter alia*, includes that the macropores are inserted into the baked blank or shaped body (such as generally tubular macropores recited in Claims 1, 3, and 21) as well as the claimed method steps (*e. g.*, the steps of compressing the powder to form blanks with micropores and then inserting the macropores).

Claim 6 has been amended to address the noted claim informalities and indefiniteness issues raised in the Action. New independent Claim 21 has been added that includes the generally uniform sintered structure with interconnected microporosity with pore widths in about the 2-15 micron range (on average), similar to original Claims 3 and/or 6. Applicants respectfully submit that Claims 6 and 21 are in condition for allowance which action is

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respectfully requested.

**B. The Claim Observations and the §112, Second Paragraph Rejections**

The Action rejects the claims for using terms and phrases that lack antecedent basis or clarity. Applicants have amended the pending claims to obviate the noted deficiencies and more clearly recite the claimed invention.

**C. Foreign Priority**

An English translation of the German language translated by Dr. Boeters is submitted herewith. The translation corresponds to the PCT application, PCT/EP00/08382, filed August 28, 2000.

As the Examiner correctly notes, this application was filed as a continuation-in-part "CIP" of the corresponding PCT application. The subject matter that was added to the specification upon the national stage filing in the U.S. is the Experimental results at page 16 and Figures 4a-5b.

**D. The Cited Prior Art**

**1. U.S. 2004/0019385 to Ayers et al.**

Claims 1-5 and 7-19 stand rejected as being anticipated by U.S. 2004/0019385 to Ayers et al. ("Ayers"). Ayer has an earliest (provisional) priority date of September 22, 2000 and claims priority to several intermediary continuation-in-part applications. The instant application has two earlier priority dates. The international PCT application, PCT/EP00/08382, was filed August 28, 2000, which is earlier than the earliest claimed priority date of Ayers. In addition, the instant application claims priority to a German priority application, DE 199 40 717.7, which was filed August 26, 1999.

As acknowledged above, the pending application is a CIP of the PCT application. Page 16 (with experimental data) was added to the specification at filing in the US (as well as Figures 4a-5b). Applicants respectfully submit that the claimed subject matter is entitled to

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the earlier priority date(s).

As the Examiner notes, although an English language translation is not typically required, 37 CFR 1.55(a)(4) states that the Office can require a translation. As noted above, Applicants are submitting a translation of the German language PCT application with a statement by the translating person stating that the translation is believed to be true and correct. In view of the foregoing, Applicants respectfully submit that the claimed subject matter is entitled to the earlier priority date and request that this rejection be withdrawn.

2. Japanese document 1-108143

Claims 1-5 and 16-19 stand rejected as being anticipated by Japanese document 1-108143 ("the Japanese reference"). More particularly, the Action states that the Japanese reference teaches "a sintered beta-tricalcium phosphate" used as an implant material. Notably, however, page 2 of the Abstract of the Japanese reference states that 10% aq. soln. of ammonium polyacrylate is added to the fired tricalcium phosphate powder to form a slurry that is poured into a given form mould and dried at room temperature for at least a day. This reference fails to teach or suggest, *inter alia*, the compressing step and/or the forming macropore step as recited in the pending claims. Hence, this reference is not an anticipatory reference and Applicants respectfully request that this rejection be withdrawn.

3. U.S. 4,195,366 to Jarcho ("Jarcho")

Claims 1-5 and 16-19 also stand rejected as being anticipated by Jarcho because of the use of "can be" terminology in the claims, which is permissive. Hence, the Action states that the claims are anticipated because Jarcho teaches a sintered beta tricalcium phosphate with a porosity. As noted above, Applicants have amended the claims to more clearly recite the claimed subject matter and cancel the "permissive" language. As such, Applicants respectfully requests that this rejection be withdrawn.

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E. The German Language References AD, AE and AF

The Examiner has refused to consider three references listed on an Information Disclosure Statement ("IDS") received by the OIPE on December 20, 2002; namely, with reference to the Form PTO 1449, German language references AD, AE and AF. Applicants are concurrently resubmitting these references on a Supplemental IDS, using the same reference identifiers (AD, AE, and AF), with a "concise statement" of relevance provided by Dr. Fabian Peters, the Head of the Technical Department for Curasan AG. Curasan AG is the successor in interest of Gerontocare GmbH, the current assignee or record of the pending application.

Further, Applicants respectfully note that the Examiner did not initial the Form PTO 1449 next to reference AA. Out of an abundance of caution, Applicants request that the Examiner initial the prior Form PTO 1449 to indicate that this reference was considered.

F. New Claims


Applicants have added new Claims 20-38 to form a more complete claim set for the application. Applicants respectfully submit that the claims are supported by the specification. For example, the figures and p. 3, ¶¶ 30 and 40 and p.4, ¶¶ 42, 48 (the citations are with reference to the printed publication of the application) describe augmentation material that includes primary particles greater than 15µm, a sintered matrix of the particles, interconnected micropores, macropores, and other characteristics of the blank or shaped body. Consideration and allowance of these claims is respectfully requested.

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G. Conclusion

Applicants submit that the present application is in condition for allowance and the same is earnestly solicited. Should the Examiner have any matters outstanding of resolution, he is encouraged to telephone the undersigned at 919-854-1400 for expeditious handling.

Respectfully submitted,

  
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**CERTIFICATION OF FACSIMILE TRANSMISSION  
UNDER 37 CFR 1.8**

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office via the central facsimile number 703-872-9306 on September 2, 2004.

  
Rosa Lee Brinson